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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,431	06/29/2001	Richard Qian	42390P11146	8957

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EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/895,431

Applicant(s)

QIAN, RICHARD

Examiner

Susan Y Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 60-86 is/are pending in the application.
- 4a) Of the above claim(s) 67-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

This office action is in response to the amendment filed on 7/14/2004.

Claims 1-59 have been canceled. Claims 60-86 are newly added,

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 60 -66, drawn to interactive smart card processing, classified in class 725, subclass 6.
- II. Claims 67-72, drawn to digital device access and control, classified in class 713, subclass 159.
- III. Claims 73-78, drawn to database or data structure application, classified in class 707, subclass 104.1.
- IV. Claims 79-86, drawn to remote data accessing, classified in class 709, subclass 217.

The inventions I, II, III and IV are related as sub-combinations disclosed as usable together in a single combination. The sub-combinations are distinct from each other if they are shown to be separately usable.

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In the instant case, invention I (interactive smart card processing) has separate utility such as using smart card for interactive transaction processing. Invention II (digital device access and control) has separate utility such as access and control multiple digital devices via communication link to a network. Invention III (database or data structure application) has separate utility such as analyzing data from multiple devices by tracking the usage data pattern. Invention IV (remote data accessing) has separate utility such as accessing credit card information stored on the remote media.

Because these inventions are distinct and search groups I, II, III and IV are not required to be simultaneous, restriction for examination purposes as indicated is proper.

A telephone interview has been conducted by the examiner (Susan Chen) and applicant attorney (Brent E. Vecchia) on 03/14/2005. The examiner has requested applicant representative to make an election of the above recited groups, in reply, the applicant selected group 1 (claims 60-66) for continuing examination without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship

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must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 60-66, are rejected under 35 U.S.C. 102(e) as being anticipated by Sehr (U.S. Patent No. 6,386,451).

As to claim 60, Sehr discloses an apparatus comprising:

- a) a portable medium [e.g., the passenger card 11, Fig. 1 and associated texts];
- b) a machine-readable medium of the portable medium [e.g. the smart card, col. 6, lines 19-20];
- c) a template database including a plurality of user preference templates that each correspond to a different electronic device [e.g., the distributed database 10, 20, 30, Fig. 1, col. 5, lines 14-26; col. 6, lines 26-54].

As to claim 61, Sehr further discloses the template database is stored on the machine-readable medium [e.g., col. 46, lines 45-50].

As to claims 62-63, Sehr further discloses the template database comprises an identification and user history template [e.g., col. 6, lines 3-18].

As to claim 64, Sehr further discloses the apparatus comprising instructions stored on the machine-readable medium that if executed cause a microprocessor of the portable medium to generate a template [e.g., col. 6, lines 19 – line 54].

As to claim 65, Sehr further discloses the portable medium comprising a smart card [e.g., col. 6, lines 19-20].

As to claim 66, Sehr further discloses the machine-readable medium having flash memory [e.g., the memory of claim 2, col. 45].

### ***Response to Amendment***

Applicant's arguments with respect to claims 31-34 and 36-59 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen  
Examiner  
Art Unit 2161

March 14, 2005



**UYEN LE**  
**PRIMARY EXAMINER**